

REMARKS

Status of Application

A Notice of Appeal, an Appeal Brief and the associated fees have been filed in connection with the above-referenced application on or before July 13, 2006.

Telephone Interviews With the Examiner

The following is set forth to make of record the substance of the telephone interviews with the Examiner in connection with the captioned application. On or about December 18, 2006, the Examiner in charge of the captioned patent application called the undersigned to discuss the claims on appeal. The Examiner stated to the undersigned that in other conversations, the Examiner and two other examiners concluded that the claims on appeal were too broad and not patentable. The basis of that conclusion was that the two other examiners were aware of prior art concerning "NASCAR trailers" and exhaust cutouts. No documentary evidence was proffered by the Examiner to substantiate the conclusion, except that the NASCAR trailers were described on the internet, and the exhaust cutouts were available online from JC Whitney Company. The Examiner suggested amendment of claim 1 to incorporate narrowing subject matter of dependent claim 6 which then was then indicated as being allowable. The undersigned suggested to the Examiner in the telephone conversation that the claims would not be amended to substantially narrow the scope thereof on the belief by the examiners of the existence of better prior art, without having an opportunity to first study such prior art.

The undersigned was scheduled to be out of the office for the holidays starting December 20, and thus an Internet search for the prior art suggested by the examiners could not be conducted until

return to the office on January 2, 2007, at which time a search of the internet was conducted to find the prior art relating to the NASCAR trailers and the JC Whitney exhaust cutouts. The undersigned could not find any relevant prior art concerning the suggested NASCAR trailers, which purportedly related to equipment for testing NASCAR engines. The undersigned did find references in the JC Whitney catalog to exhaust cutouts, which is made of record in the attached Information Disclosure forms. The undersigned conducted further searching of the PTO database for prior art patents relating to exhaust cutouts. The results are identified in the attached PTO Information Disclosure forms.

In a subsequent telephone conference with the Examiner in the first week of January, 2007, the undersigned explained the art of exhaust cutouts as described in the prior art found by the undersigned. The undersigned suggested an amendment to claim 1 to include the phrase “*modify properties of fuel to be combusted by said engine and thereby*” to overcome the exhaust cutout prior art. On or about January 8, 2007 (Friday), the Examiner left a message with the undersigned that the suggested amendment would be approved if claim 1 were further amended in the following manner: “*modify the physical properties of fuel to be combusted by said engine and thereby.*” In the message, the Examiner indicated that the modified amendment of claim 1 would have to be approved by the undersigned that day (Friday). Unfortunately, the undersigned did not receive the message until Monday morning, whereupon the undersigned left a message with the Examiner that the amendment, as modified by the Examiner, was approved.

In a subsequent telephone interview with the Examiner, it was indicated that an election/restriction requirement was being prepared and would be mailed.

Amendment of Claims 1 and 26

Claims 1 and 26 have been amended to overcome the prior art identified in the PTO form

SB/08A and B submitted herewith.

Election/Restriction Requirement

In the Office Action dated January 18, 2007, the Examiner requires restriction of the claims which are alleged to define distinct inventions. The Examiner considers restriction of the following claims:

- I. Claims 1-6, 8-11 and 15, drawn to an aftermarket device comprising a magnet, classified in class 123, subclass 538.
- II. Claims 1-3, 5 and 13 drawn to a catalytic converter switchable into and out of operation, classified in class 181, subclass 236.
- III. Claims 1-3 and 14, drawn to a variable load switchable into and out of operation, classified in class 701, subclass 53+.

The Examiner does not consider claims 21-27 as being subject to the restriction requirement, as such claims are not addressed in the restriction requirement.

The basis for the restriction requirement is that the inventions of Groups I, II and III are related as subcombinations disclosed as usable together in a single combination.

Election of Claims

Applicant elects for examination the claims of Group I, namely claims 1-6, 8-11 and 15.

Traversal

Applicant hereby traverses the restriction requirement as it is without proper basis for the following reasons, and the Examiner has not met all of the formal requirements for restriction.

1. Untimely

First, the restriction requirement is extremely untimely, as it has been issued after the examination on the merits has been made final, and after the application has been appealed by the Applicant. MPEP §811 states that a restriction requirement should be made before any action on the merits, or as early as possible...*at any time before final action*.

The history of examination of the claims is set forth below:

a) In an Office Action dated January 4, 2005, the Examiner mailed a paper requiring election of species. The Applicant responded by electing a certain species to be examined.

b) On March 31, 2005 a first non-final action on the merits was mailed, whereupon the Applicant responded. In the first non-final Office action, dependent claim 6 was rejected as being obvious over U.S. Pat. No. 4,932,628 by Pacheco in view of U.S. Pat. No. 5,637,226 by Adam et al. Claims 13 and 14 were rejected as being obvious in view of U.S. Pat. No. 4,932,628 by Pacheco. Claims 8-11, 24 and 25 were indicated as being drawn to allowable subject matter.

c) On July 28, 2005 a second non-final Office Action was mailed, whereupon the Applicant responded. In the second non-final Office Action, the claims at issue, including claims 6, 13 and 14 were rejected as being obvious over the Pacheco reference in view of the Adam et al reference. In this second non-final Office Action, the Examiner indicated that only claims 8 and 9 were drawn to

allowable subject matter.

d) On January 13, 2006 the Examiner mailed a final Office Action. The rejection of claims 6, 13 and 14 in the final Office Action was maintained over the prior art of Pacheco and Adam et al. The Examiner again indicated that only claims 8 and 9 were drawn to allowable subject matter. In response to the final Office Action, the Applicant appealed the final rejection of the claims on April 13, 2006.

From the foregoing, it is believed that the Examiner conducted an initial search and examination of all of the appealed claims in the application prior to the mailing of the first non-final Office Action. The claims 6, 13 and 14 were rejected over certain prior art in the first non-final Office Action, and over a different combination of prior art references in the second non-final Office Action. The claims subject to the present restriction requirement were not substantively amended before or after the Final Office Action. In the examination of the claims, the Examiner previously conducted a search of the appealed claims in order to determine the patentability thereof. It is apparent that the purported "burden" of examination at this late date is not well founded, as such claims were previously subject to vigorous examination and arguments concerning patentability thereof. The burden of conducting an additional search and examination of all of the claims initially elected has already been carried out, unless it is the admission of the Examiner that the captioned application has not been properly examined according to the rules of practice, and thus the standard search necessary to complete the examination must now be conducted after an appeal brief has been filed.

Secondly, the restriction requirement is untimely, in that it occurs at a time that substantially prejudices the Applicant in terms of traversal and review. The Examiner has chosen to require election of the claims after a final rejection of the claims and after an appeal has been lodged by the Applicant. The prejudice to the Applicant exists because 37 CFR § 1.144 allows a petition from a restriction

requirement to be filed after a final office action, but no later than appeal. Accordingly, having appealed the captioned application, Applicant will be severely prejudiced by not being able to petition the present restriction requirement.

2. Improper

Notwithstanding the foregoing, the restriction requirement is improper as the grouping of claims set forth by the Examiner do not define distinct inventions.

The Examiner required election of one of the three claim groups, namely:

Group I - Claims 1-6, 8-11 and 15, drawn to an aftermarket device comprising a magnet.

Group II - Claims 1-3, 5 and 13 drawn to a catalytic converter switchable into and out of operation.

Group III - Claims 1-3 and 14, drawn to a variable load switchable into and out of operation.

First of all, the Examiner is in error in the grouping of claims, as Group I claims 1-5, 7, 10 and 15 are not drawn to an aftermarket apparatus comprising a magnet, as stated in the restriction requirement.

Secondly, the Examiner is in error in the grouping of claims, as Group II claims 1-3 and 5 are not drawn to a catalytic converter switchable into and out of operation, as stated in the restriction requirement.

Thirdly, the Examiner is in error in the grouping of claims, as Group III claims 1-3 are not drawn to a variable load switchable into and out of operation, as stated in the restriction requirement.

The Groups I, II and III all include claims 1-3. The question is how claims 1-3 can define

distinct inventions when they define the same subject matter. Stated another way, if Applicant elected Group I Claims for examination and was successful in gaining allowance so that a patent issued thereon, how could Applicant file a divisional application on either the Group II or Group III set of claims - with identical claims 1-3? Simply stated, the grouping of claims by the Examiner will not support different patents, and thus the Examiner failed to comply with 35 U.S.C. §121 cited in the restriction requirement. The Examiner is thus requiring the Applicant to divide the claims into groups that are not distinct, and thus the restriction requirement should be withdrawn as failing to comply with the rules and statutes.

The Examiner has concluded that the three groups of claims define respective subcombinations usable in a single combination. Apparently, claims 1-6, 8-11 and 15 of Group I define a subcombination usable in some combination not described by the Examiner. Similarly, claims 1-3, 5 and 13 of Group II define another subcombination, also usable in some combination not defined. Lastly, claims 1-3 and 14 of Group III define yet another subcombination usable in some combination.

There is no separate utility of all of the various claims of the different Groups, and thus the grouping of claims is improper.

With regard to the Group I claims, it should be noted that the magnets of claims 6, 8 and 9 relate to the aftermarket apparatus claimed in claim 1. However, the catalytic converter of claim 13 of Group II and the variable load of claim 14 of Group III are not required to be the switched aftermarket apparatus specified in claim 1.

The Examiner has grouped dependent claim 5 with Group II claims. The subject matter of claim 5 depends from dependent claim 2, and thus specifies a visual display for visually showing the difference in operation of the aftermarket apparatus on pollutants emitted from the engine when the

aftermarket apparatus is operational and nonoperational. The subject matter of dependent claim 5 is erroneously grouped with the Group II claims (which apparently relate to the catalytic converter), as the pollutants emitted from the engine need not be processed by a catalytic converter. Rather, the pollutants emitted from the engine equipped with the aftermarket apparatus can be measured and displayed even in the absence of a catalytic converter, or can be measured before the exhaust enters the catalytic converter to obtain a better measure of the pollutants before they are eliminated, changed or reduced by the catalytic converter. Again, commensurate with the inconsistent grouping of claims for restriction, the Examiner has included claim 5 in both Group I and Group II.

3. Serious Burden of Searching

The burden of searching the claims of the three groups has already been carried out by the Examiner during the first, second and third Office Actions. Independent claim 1 was certainly the focus of the searching effort. Claim 1 is now included in all three groups that Examiner has concluded define distinct subcombinations. Notwithstanding, there is an equal burden of searching claims 1-3 again, irrespective of which group Applicant elects to continue for examination. Stated another way, the burden of searching the prior art again for the subject matter of claims 1-3 is irrelevant in the present circumstances, as a search will be necessitated in the same area and classes irrespective of which Group of claims is elected. In addition, if it is found that independent claim 1 is patentable, then the dependent claims relating to the catalytic converter (claim 13) and the variable load (claim 14) will be patentable as well, as they depend from claim 1.

The common core of the groups of restricted claims is that set forth in independent claim 1, which appears in Group I, Group I and Group III. Once the subject matter of independent claim 1 has been searched (which it should have been searched before the first Office Action was mailed), then the largest effort has been completed. And, as noted above, this search effort must be completed

irrespective of the claim Group elected for further examination.

It is submitted that the search of subject matter of dependent claim 13 would not be burdensome, as it requires the searching of a catalytic converter that is switched into and out of operation with respect to exhaust gasses of the engine. This is not a complicated claim with a large number of elements or limitations to be searched.

Similarly, the subject matter of claim 14 is not complicated, as it specifies an engine load that is switchable into and out of operation. Again, because of the simplicity of the subject matter of dependent claim 14, is believed that such claim can be efficiently searched with relative ease.

As noted above, the catalytic converter of claim 13 and the engine load of claim 14 are not the "aftermarket apparatus" specified in claim 1. Rather, the switchable catalytic converter of claim 13 and the switchable load of claim 14 are switchable in addition to the aftermarket apparatus of claim 1. Both claims 13 and 14 depend from claim 1 and specify the subject matter of claim 1 "further includes" a switchable catalytic converter and a switchable load. To that end, it is believed that dependent claims 13 and 14 are not claims relating to subcombinations, as stated by the Examiner.

While the searching effort is an issue to be considered in the restriction of claims, it should be noted that the efficient use of the resources of the U.S. Patent and Trademark Office should also be considered in further extending the examination of the claims of the captioned application, on the issue of whether certain claims of the application (which have already undergone vigorous examination) are distinct from each other. Heretofore, the Applicant and the Examiner have exchanged numerous written papers concerning the claims, numerous conversations have been conducted by way of telephone, the issues of all of the claims have already been brought into focus, and the undersigned has conducted internet searching at the behest of the Examiner for the exhaust cutout art and the NASCAR

trailer art. It is well past time to proceed with the patentability of the claims on the merits, rather than focus on restriction of the claims after the case has been appealed. From the foregoing, it is the belief of the Applicant that he is being punished by the Examiner because the Applicant did not take the advice of the Examiner in amending claim 1 to include the subject matter of claim 6, as mentioned in the telephone interview.

Conclusion

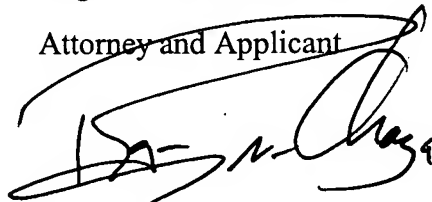
The claims of Groups I-III are not distinct in the manner described by the Examiner, there is no substantial burden of searching the subject matter of the few dependent claims at issue, the lodging of the restriction requirement is highly untimely, separate patenting of the claims in the three groups would not be sanctioned by the U.S. Patent and Trademark Office and indeed would violate the statutes, and thus the restriction requirement should be withdrawn in its entirety.

It is respectfully requested that the Examiner reconsider the restriction requirement and withdraw the same, and examination concluded so that appeal of the case can be continued.

Respectfully submitted,

Roger N. CHAUZA, P.C.

Attorney and Applicant

A handwritten signature in black ink, appearing to read "Roger N. Chauza", is written over the printed name and title.

Roger N. Chauza, Esq.

Registration No. 29,753

Telephone: (972) 518-1414

RNC/mc